



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/776,034	02/01/2001	Tonny Yu	60016-0011	7081

37490 7590 07/27/2005

CARPENTER & KULAS, LLP  
1900 EMBARCADERO ROAD  
SUITE 109  
PALO ALTO, CA 94303

EXAMINER

HARRELL, ROBERT B

ART UNIT PAPER NUMBER

2142

DATE MAILED: 07/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/776,034

Applicant(s)

YU, TONNY

Examiner

Robert B. Harrell

Art Unit

2142

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 14 February 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-78 is/are pending in the application.
- 4a) Of the above claim(s) 13-22, 34-41, 52-59 and 70-77 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12, 23-33, 42-51, 60-69 and 78 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 February 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 20010504 et al.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☒ Other: see attached Office Action.

PD

Art Unit: 2142

### Electronic

1. Claims 1-12, 23-33, 42-51, 60-69, and 78 are presented for examination with claims 13-22, 34-41, 52-59, and 70-77 withdrawn as directed to the non-elected invention.

2. The applicant's February 2005 election of Group-I (claims 1-12, 23-33, 42-51, 60-69, and 78), from examiner's restriction requirement of January 2005, is noted. However, since the election did not specifically rebut the restriction requirement, the election is nonetheless treated as an election without traverse. The restriction requirements are hereby incorporated into this action by reference and made FINAL.

3. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

4. The applicant should use this period for response to thoroughly and very closely proof read and review the whole of the application for correct correlation between reference numerals in the textual portion of the Specification and Drawings along with any minor spelling errors, general typographical errors, accuracy, assurance of proper use for Trademarks <sup>TM</sup>, and other legal symbols ®, where required, and clarity of meaning in the Specification, Drawings, and specifically the claims (i.e., provide proper antecedent basis for "the" and "said" within each claim). Minor typographical errors could render a Patent unenforceable and so the applicant is strongly encouraged to aid in this endeavor.

5. 35 U.S.C. 101 reads as follows:

**Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.**

6. Claims 25-33 and 42 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Specifically, the claims recite a computer-readable medium "carrying" one or more sequences of instructions. The medium is not restricted from, does not exclude, "carrying" other information and thus could encompass music and other printed matter and/or data structure per se'. (In re Beauregard (CAFC) 35 USPQ2d 1383) and MPEP 2106). This rejection can be mooted by amending the claims with the suggested phrase "One or more sequences of instructions embodied on a computer readable medium". Amending the claims as such would NOT be a change in scope with respect to making any subsequent action final.

7. The following is a quotation of the second paragraph of 35 U.S.C 112:

**The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.**

Art Unit: 2142

8. Claims 1-12, 23-33, 42-51, 60-69, and 78 are rejected under 35 U.S.C 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention. The scope of meaning of the following claim language is not clear:

- a) "the computer-implemented steps"--claims 1 and 23 (line 2), claim 2 et seq.;
- b) "the electronic message"—claim 23 (line 12)[\*note lines 1-2 and 10\*].

9. As to 8 (a and b) above, these are but a few examples of numerous cases where clear antecedent basis are lacking and not an exhausting recital. Any other term(s) or phrase(s) over looked by examiner and not listed above which start with either "the" or "said" and do not have a single proper antecedent basis also is indefinite for the reasons outlined in this paragraph. Also, these are but a few examples where term(s) or phrase(s) are introduced more than once without adequate use of either "the" or "said" for the subsequent use of the term(s) or phrase(s). Moreover, multiple introduction of a term, or changes in tense, results in a lack of clear antecedent basis for term(s) or phrase(s) which relied upon the introduced term. Failure to correct all existing cases where clear antecedent basis are lacking can be viewed as non-responsive. Nonetheless, should a response yield all claims allowable short *a few* cases where clear antecedent basis are lacking within the claims, a preemptive authorization to enter an examiner's amendment to the record to correct such would accelerate a notice of allowance over a final rejection. Such could be added at the end of an applicant's response with the following statement: "Examiner is hereby authorized, without the need of further contact by examiner, to enter an Examiner's Amendment to correct any cases where antecedent basis are lacking." if the applicant so elects. This does not diminish the applicant's requirement to correct all such cases not so listed in the example few given above nor prohibit any amendments after a notice of allowance by the applicant.

10. Per claims 25-33 and 42, it cannot be clearly ascertained if the computer readable medium only carries one or more sequences of instructions as claimed or if other information is also embodied on the computer readable medium.

11. All claims directly, or by inheritance, recite "associated with". However, the relationship cannot be clearly ascertained in the manner recited in the claims since an address is, normal in the art, associated only with one entity. Thus it cannot be clearly ascertained if the address is shared between more than one entities (i.e., someone@someplace.com can be accessed by more than one entity) or if a message to one address is actually duplicated in more than one mailbox or some other scenario. The issue is further compounded by "using the address". Who or what uses such an address (i.e., last line of claim 1)? Is/are the address(es) the same (i.e., does the user use the resource's address to use the resource?)? For example, and not limiting the claims hereto, user Joe has a normal address, such as joe@someplace.com for all normal correspondences. However, Joe also wishes to subscribe to the Yack-A-Lot mailing list and thus is given (generated) joe@yackalot.com; and it be this address, joe@yackalot.com, and not Joe's normal email address of joe@somplace.com, that Joe and the resource finally communicate

Art Unit: 2142

the email message(s) not via Joe's normal email address of joe@someplace.com; OR, if joe@someplace.com is the selected venue of communication or some other means thereof or in combination therewith. Examiner queries if the claims could read on private mailing lists such as for example, if Joe subscribed to CIA topic in TOP-SPY-4-US Joe would be given the address joe@cia.top-spy-4-us.com if Joe wished to only read CIA related messages rather than KGB which then would be joe@kgb.top-spy-4-us.com and thus Joe would have two email addresses as so listed. OR, if the claims read on conventional free mail servers such as joe19332s@yahoo.com from which Joe conducts conversations with a mailing list about Mars. The phrase "only associated with" does not exclude intruders. That is, Joe and Jane share personal email using a secret mailbox most recently discovered by a snooping spammer. Thus "associated with" is vague and has no meaning as the spammer is now apart of the accessible group. Finally, it is not certain if the claim read simply on Joe subscribing to a new Internet Service Provider that provides an email resource. That is, Joe subscribes to SlickLightingFast.com, a hypothetical (every example herein is hypothetical) dial up Internet Provider; since Joe is subscribing to this Internet Provider Joe also would want the email resource provided by SlickLightingFast.com and is thus assigned joe@slicklightingfast.com which is associated only with Joe (i.e., joe@) and the email resource (@slicklightingfast.com) the intermediary being the mail server within the SlickLightingFast domain (most internet providers have more then one machine (i.e., a web server, a mail server, and ftp server, and irc server, and exc...). Taking all of these examples into consideration, examiner is unable to clearly view the scope of the claimed invention since the meets and bounds are endless with each example given reading on different inventions defined within the elected claims. The same holds for the plurality of additional addresses and/or with each instance of "associated with". Due to this, the claims are almost unsearchable since examiner stands at a fork in the road with an endless possible routes to flow; which to explore? Examiner elects joe@yackalot.a-macine.com akin to, and in light with, the applicant's specification.

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this action:

**A person shall be entitled to a patent unless -**

**(e) the invention was described in — (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for the purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language;**

13. Claims 1-12, 23-33, 42-51, 60-69, and 78 are rejected under 35 U.S.C. 102 (e) as being anticipated by Chen (US 6,836,792 B1).

Art Unit: 2142

14. Prior to addressing the grounds of the rejections below, should this application ever be the subject of public review by third parties not so versed with the technology (i.e., access to IFW through Public PAIR (as found on <http://portal.uspto.gov/external/portal/pair>)), this Office action will usually refer an applicant's attention to relevant and helpful elements, figures, and/or text upon which the Office action relies to support the position taken. Thus, the following citations are neither all-inclusive nor all-exclusive in nature *as the whole of the reference is cited* and relied upon in this action as part of the substantial evidence of record. Also, no temporal order was claimed for the acts and/or functions. With respect to the submitted IDS PTO-FORM-1449 of record, all references therein mentioned having been fully considered and reviewed by examiner, the following additional reference to Chen (US 6,836,792 B1) is also introduced and made apart of the substantial evidence of record subsequent to a full and detailed search.

15. To the best examiner can understand the invention defined in the claims, Chen (having an effective filing date of 03 December 1999 predating 01 February 2001 of this application) taught a method (e.g., see Abstract) for using a computer-implemented intermediary (e.g., see figure 1) to filter electronic messages (i.e., "spam" of col. 7 (line 16)(e.g., see col. 7 (line 21 "filtering")), the method comprising the computer-implemented steps (e.g., see figure 4 and figure 6) of: receiving, at the intermediary (e.g., see figure 3 (302)), a request from a user to subscribe (e.g., see Abstract) to an e-mail resource (i.e., a "mailing list" of col. 7 (line 23)) and generating an address (i.e., abc@xyz.middleware.com" (for example joe@somplace.yackalot.com)) that is only associated with the user and the e-mail resource (e.g., see col. 6 (lines 41-58)) and sending, from the intermediary in response to the request, the address to the e-mail resource in order to subscribe the user to the e-mail resource using the address (e.g., see Abstract and col. 5 (line 14-et seq.)) and receiving, from the e-mail resource, an electronic message the includes the address and identifying whether the electronic message is an unwanted electronic message (i.e., spam), and when the electronic message is not identified as said unwanted electronic message, providing the electronic message to the user (e.g., see col. 7 (line 26-et seq.)). While non-spam is forwarded, the user can elect to obtain the spam.

14. Akin with Joe above, when user "abc" of col. 6 (line 50) subscribes to a mailing list, as covered in col. 7 (line 23), user "abc" is assigned a mailing list address of abc@xyz.middleware.com per col. 6 (line 52) in order that the system can filter spam per col. 7 (lines 15-25) which mail list address is only associated with the user and the mailing resource. It should be noted that "middleware" is an example name; any name could be conceived of which names, per se, are not patentable subject matter but rather subject to Trademarks.

15. Per claims 2, 3, 4, 5, 6, 7, 8, 9, 10, 11 and 12, Chen does not limit his invention to only one user and one mailing list. Thus, since there are plural users and plural mailing list, so in like turn are there a plurality of email addresses each paired between a user and a service. These addresses would have been the forwarding address by which was the standard "forward" in SMTP in a manner of col. 7 (line 26-et seq.) of which the user(s) could select the mail message to read from a grouped list provided by standard POP3 in/on the Internet as implied by col. 5 (line 33 for "SMTP") while electively ignoring "spam" of col. 7 (line 26-et seq.) identified by a

Art Unit: 2142

list of undesirable/unauthorized email address(es) or contents of spammers (i.e., a spam filter/blocker specifically for virus scanners (scanning implies content search) that have hidden message payloads (i.e., cookies) (i.e., the first of known viruses was called GREEN-CARD a virus with a payload message advertising the solicitation of Green Cards)). Where, per the Abstract of Chen, the user would subscribe to a mailing list in a conventional manner by entering information into a displayed subscription form which was normally an email and thus a sample.

16. Per claims 23-33, 42-51, 60-69, and 78, these claims do not teach or defined above the correspondingly rejected claims given above, and are thus rejected for the same reasons given above. However, Chen was a computer system and thus implemented computer-readable mediums embodied thereon one or more sequences of instructions to conduct the invention disclosed by Chen. The applicant's defined invention also is covered by means-plus-function. As given above, the corresponding structures were also taught by Chen (i.e., page 17 of this applications specification and col. 6 (line 41) to col. 7 (line 25) as examples). It is noted that page 17 of this applications stated the generated names are but examples as is with Chen, only examples. Thus user "abc" could also have been assigned abc123@mial-list-topic.middleware.com; such formation of an email address would not be patentable subject matter and is not the thrust of the disclosed invention therefor not a patentable distinction. Further more, per col. 6 (line 50), "xyz" was the service (i.e., the name and topic of a mailing list) and thus abc@xyz.middleware.com would be akin to page 17 of this application in that user name, mail list topic as subdomain, and domain name were all used in the email address too. That is, user "zek294", of page 17, was user "abc" of col. 6 (line 50), "sports" the topic and subdomain of a subscribed mailing list, of page 17, as was "xyz" the topic and subdomain of that service (i.e., mailing list) while "mailshell.com", of page 17, the top domain as was "middleware" of col. 6 (line 52); thus the two generated an address in the general format of: user@topic.intermediary.com. It is also noted that page 18 of this application recited that some characters of the email address need not be randomly generated. As can be seen between col. 6 (lines 50 and 52) "abc" was in common as was "xyz". Nonetheless, the format of an email address is a data structure and not a patentable distinction. Thus, with respect to "means-plus-function" examiner has shown a correlation between actual items, or their equivalent, within the specification of this application and the applied reference herein this Office Action. Since the Internet was disclosed by Chen, so was a network and network interface along with one or more processors coupled to the network via the network interface to conduct the invention disclosed by Chen.

17. In conclusion, with respect to the rejection outlined above, in Chen, an address, formatted in the manner outlined above, was only associated with a requesting subscribed user and an email mail list resource to thwart spamming among users of an email list. That is, a subscriber to a mailing list was given an email address.

18. The following is a quotation of 35 U.S.C. 103 which forms the basis for all obviousness rejections set forth in this office action:

Art Unit: 2142

**a) a patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.**

19. Claims 1-12, 23-33, 42-51, 60-69, and 78 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chen (US 6,836,792 B1).

20. The grounds provided above are hereby incorporated herein this Office Action in their totality.

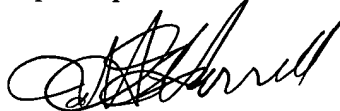
21. That which was anticipated was obvious. Any argued details not fully covered by Chen (i.e., SMTP as an example) were obvious variations to incorporate since Chen made direct reference to such (sendmail, for example, was/is a very complex email system not detailed by Chen but an obvious usage by Chen when reciting Internet/SMTP and thus the hole of sendmail therein incorporated by reference, as an example). Therefor, that which was anticipated by inheritance, while anticipated and/or obvious (i.e., one need not teach the actual flipping of a light switch to the "on" position when one teaches the presences of a conventional light switch on a wall wired to a conventional room light source when the bulk of the disclosed invention is directed to the novel layout of an game room).

22. A shortened statutory period for response to this action is set to expire 3 (three) months and 0 (zero) days from the data of this letter. Failure to respond within the period for response will cause the application to become abandoned (see MPEP 710.02, 710.02(b)).

23. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert B. Harrell whose telephone number is (571) 272-3895. The examiner can normally be reached Monday thru Friday from 5:30 am to 2:00 pm and on weekends from 6:00 am to 12 noon Eastern Standard Time.

24. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew T. Caldwell, can be reached on (571) 272-3868. The fax phone number for all papers is (703) 872-9306.

25. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-9600.



ROBERT B. HARRELL  
PRIMARY EXAMINER  
GROUP 2142